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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,181	02/25/2004	Harry Bennett	BEN-1203	2383
7590	04/14/2005		EXAMINER	
Carl D. Crowell P.O. Box 923 Salem, OR 97308			CHIN, RANDALL E	
			ART UNIT	PAPER NUMBER
			1744	

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/786,181	Applicant(s) BENNETT, HARRY	
	Examiner Randall Chin	Art Unit 1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2005 and 21 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 6 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5 and 10 is/are rejected.
- 7) ☒ Claim(s) 4 and 7-9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 1, 10 and 11 are objected to because of the following informalities:

Claim 1, line 3, after "of", insert --said--.

Claim 1, line 8, after "allowing", insert --said--.

Claim 10, line 1, delete "a".

Claim 11, line 3, after "of", insert --said--.

Claim 11, line 6, after "allowing", insert --said--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Blanchard '387.

Blanchard '387 discloses a masonry tuck point tool in Fig. 1 characterized as a "double pointer", comprising a selected tuck blade and at least one remaining tuck blade pivotally attached at a first end 14 (p. 2, lines 31-33), said selected tuck blade and each of said remaining tuck blades having a distinct blade width (p. 2, lines 38-40), wherein said selected tuck blade is pivoted approximately 180 degrees away (Fig. 1) from said

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at least one remaining tuck blade thereby allowing said at least one remaining tuck blades to be used as a handle (p. 2, lines 36-38) at said first end while said selected tuck blade is utilized for striking a masonry joint with a second end opposite said first end of said at least one remaining tuck blades.

As for claim 10, the blades appear to have similar blade lengths (Fig. 1).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blanchard '387.

As for the tuck blades being made from rigid spring steel, one skilled in the art would find it obvious to utilize this material in order to provide for durability as well as some flexibility to avoid breaking the tool.

As for the tuck blades being made from hard plastic, one skilled in the art would find it obvious to utilize this material in order to provide for durability and since such material is widely available on the market.

6. Claims 1, 2 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson '346.

Anderson '346 discloses a caulking or pointing tool comprising a selected tuck blade and at least one remaining tuck blade pivotally attached at a first end 22 (Figs. 1 and 3), said selected tuck blade and each of said remaining tuck blades having a distinct blade width (col. 3, lines 23-24), wherein said selected tuck blade is pivoted approximately 180 degrees away (Fig. 3) from said at least one remaining tuck blade thereby allowing said at least one remaining tuck blades to be used as a handle at said first end while said selected tuck blade is utilized for striking a joint with a second end opposite said first end of said at least one remaining tuck blades. As for the recitation "masonry tuck point tool" in claim 1, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

As for claim 2, the blades are "rigid" (merely relative term) spring steel (col. 3, lines 22-23).

As for claim 10, the blades are similar lengths (Fig. 1).

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson '346.

As for blades being made from hard plastic, one skilled in the art would find it obvious to utilize this material in order to provide for durability and since such material is widely available on the market.

***Claim Rejections - 35 USC § 102***

8. Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Bakke '558.

Bakke '558 discloses a tool comprising a selected "blade" and at least one remaining "blade" pivotally attached at a first end 10 (Figs. 3-6), said selected blade and each of said remaining blades having a distinct blade width (Fig. 1), wherein said selected blade is pivoted approximately 180 degrees away (Figs. 3 and 5) from said at least one remaining blade thereby allowing said at least one remaining blades to be used as a handle at said first end while said selected blade is utilized for striking a joint with a second end opposite said first end of said at least one remaining blades. As for the recitations "masonry tuck point tool" and "tuck blades" and in claim 1, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

As for claim 3, the "blades" or templates can be of hard plastic (col. 1, lines 55-59).

As for claim 5, the "blades" are of distinct lengths (Figs. 1 or 2).

### ***Conclusion***

9. Applicant's arguments filed 15 February 2005 have been fully considered but they are not persuasive.

Applicant primarily argues that Blanchard's device is distinct in utility and elements and "without analog" to Applicant's claims.

The Examiner respectfully disagrees. It is the position of the Examiner that Blanchard '387 discloses all of the recited subject matter of claim 1. Notwithstanding the fact that Blanchard's device is termed a "double pointer," Blanchard's device discloses the structure to still meet claim 1 as amended. Applicant points out that Blanchard's Fig. 1 is a side elevation "partially in section" and "not in a position of utility or functionality and is simply illustrative." The Examiner respectfully disagrees since Blanchard even explicitly states that "one set of plates constitutes a handle for the manipulation of the opposite set" (p. 2, lines 36-38). Thus, Blanchard teaches one "blade" being used as a handle as is claimed and is functional. Also, one set of plates 10, 10 will constitute a handle for the opposite set of plates 10, 10.

***Allowable Subject Matter***

10. Claim 11 is allowed.

Claims 4 and 7-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Any inquiry concerning this communication or earlier communication from the Examiner should be directed to Randall Chin whose telephone number is (571) 272-1270. The Examiner can normally be reached on Monday through Thursday and every other Friday.

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, John Kim, can be reached at (571) 272-1142. The number for Technology Center 1700 is (571) 272-1700.

The central fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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R. Chin



Randall Chin  
Primary Examiner  
Art Unit 1744